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TECH CENTER 1600/2900
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Girish V. Shah

SERIAL NO.: 09/251,133

FILING DATE: 17 February 1999

TITLE: NEUROENDOCRINE MARKER
OF PROSTATE CANCER AND
METHOD FOR PRODUCING SAME

EXAMINER: A. Holleran

AU: 1642

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Assist. Commissioner for Patents
Washington, D.C. 20231

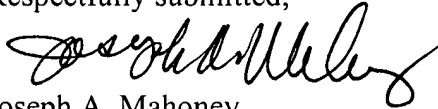
**RESPONSE TO NOTICE TO COMPLY WITH REQUIREMENTS
FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE AND/OR
AMINO ACID SEQUENCE LISTING DISCLOSURES**

Dear Sir:

The remarks below are provided in response to the Examiner's communication dated October 4, 2000. Attached hereto is a petition for a two month extension of time under 37 C.F.R. § 1.136. Enclosed is a check in the amount of \$195.00, the necessary fee under 37 C.F.R. § 1.17(a)(1) for said two month extension. Applicant considers this response to have been timely filed pursuant to 37 C.F.R. § 1.7 and § 1.8. Payment of this fee, however, is under protest because Applicant did not receive the Examiner's communication until December 5, 2000. The attorney docketed copy of the Examiner's communication is enclosed herewith. Further, Applicant provided the Examiner a "Notice of Change of Address of Attorney of Record" in the response to the Examiner's communication dated June 20, 2000. Therefore, Applicant's request a refund of the fee provided with this response. The Commissioner is hereby authorized to charge any deficiency in fees associated with this communication, or credit any overpayment to Deposit Account No. 19-3140.

In response to the Examiner's communication dated October 4, 2000 requiring Applicant to furnish nucleotide and/or amino acid sequence listing complying with Patent Office standards in the above-referenced application, Applicant encloses herewith a sequence listing in printed and computer readable form. Applicant confirms that the sequence listing provided herewith does not go beyond the disclosure in the international application as filed. Applicant further encloses a copy of the Notice to Comply as requested in the Examiner's communication.

Respectfully submitted,



Joseph A. Mahoney
Reg. No. 38,956

December 19, 2000

SONNENSCHN, NATH & ROSENTHAL
8000 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6404
(312) 876-8192

Docket No. 70009590-0015

Application No.: 09/251,133

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☒ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other:

Applicant Must Provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☐ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

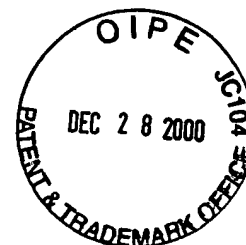
For CRF Submission Help, call (703) 308-4212

PatentIn Software Program Support (SIRA)

Technical Assistance.....703-287-0200

To Purchase PatentIn Software.....703-306-2600

PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE



**RAW SEQUENCE LISTING
ERROR REPORT**

BIOTECHNOLOGY
SYSTEMS
BRANCH

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SEP 25 2000

The Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) detected errors when processing the following computer readable form: TECH CENTER 1600/2900

Application Serial Number: 09/257,133

Source: 1642

Date Processed by STIC: 9/20/2000



THE ATTACHED PRINTOUT EXPLAINS DETECTED ERRORS.

PLEASE FORWARD THIS INFORMATION TO THE APPLICANT BY EITHER:

- 1) INCLUDING A COPY OF THIS PRINTOUT IN YOUR NEXT COMMUNICATION TO THE APPLICANT, WITH A NOTICE TO COMPLY RECEIVED
JAN 11 2001
TECH CENTER 1600/2900
or,
- 2) TELEPHONING APPLICANT AND FAXING A COPY OF THIS PRINTOUT.
WITH A NOTICE TO COMPLY

FOR FURTHER INFORMATION, PLEASE TELEPHONE MARK SPENCER,
703-308-4212.

TO REDUCE ERRORED SEQUENCE LISTINGS, PLEASE USE THE CHECKER
VERSION 3.0 PROGRAM ACCESSIBLE THROUGH THE U.S. PATENT AND
TRADEMARK OFFICE WEBSITE. SEE BELOW:

Checker Version 3.0

The Checker Version 3.0 application is a state-of-the-art Windows based software program employing a logical and intuitive user-interface to check whether a sequence listing is in compliance with format and content rules. Checker Version 3.0 works for sequence listings generated for the original version of 37 CFR §§1.821 - 1.825 effective October 1, 1990 (old rules) and the revised version (new rules) effective July 1, 1998 as well as World Intellectual Property Organization (WIPO) Standard ST.25.

Checker Version 3.0 replaces the previous DOS-based version of Checker, and is Y2K-compliant. Checker allows public users to check sequence listings in Computer Readable form (CRF) before submitting them to the United States Patent and Trademark Office (USPTO). Use of Checker prior to filing the sequence listing is expected to result in fewer errored sequence listings, thus saving time and money.

Checker Version 3.0 can be down loaded from the USPTO website at the following address:
<http://www.uspto.gov/web/offices/pac/checker>

Raw Sequence Listing Error Summary

ERROR DETECTED SUGGESTED CORRECTION

SERIAL NUMBER

09/251,123

ATTN: NEW RULES CASES: PLEASE DISREGARD ENGLISH "ALPHA" HEADERS, WHICH WERE INSERTED BY PTO SOFTWARE

- 1 Wrapped Nucleics The number/text at the end of each line "wrapped" down to the next line. This may occur if your file was retrieved in a word processor after creating it. Please adjust your right margin to .3, as this will prevent "wrapping".
- 2 Wrapped Amino The amino acid number/text at the end of each line "wrapped" down to the next line. This may occur if your file was retrieved in a word processor after creating it. Please adjust your right margin to .3, as this will prevent "wrapping".
- 3 Incorrect Line Length The rules require that a line not exceed 72 characters in length. This includes spaces.
- 4 Misaligned Amino Acid Numbering The numbering under each 5th amino acid is misaligned. This may be caused by the use of tabs between the numbering. It is recommended to delete any tabs and use spacing between the numbers.
- 5 Non-ASCII This file was not saved in ASCII (DOS) text, as required by the Sequence Rules. Please ensure your subsequent submission is saved in ASCII text so that it can be processed.
- 6 Variable Length Sequence(s) contain n's or Xaa's which represented more than one residue. As per the rules, each n or Xaa can only represent a single residue. Please present the maximum number of each residue having variable length and indicate in the (ix) feature section that some may be missing.
- 7 PatentIn ver. 2.0 "bug" A "bug" in PatentIn version 2.0 has caused the <220>-<223> section to be missing from amino acid sequence(s) . Normally, PatentIn would automatically generate this section from the previously coding nucleic acid sequence. Please manually copy the relevant <220>-<223> section to the subsequent amino acid sequence. This applies primarily to the mandatory <220>-<223> sections for Artificial or Unknown sequences.
- 8 Skipped Sequences (OLD RULES) Sequence(s) missing. If intentional, please use the following format for each skipped sequence:
(2) INFORMATION FOR SEQ ID NO:X:
(1) SEQUENCE CHARACTERISTICS: (Do not insert any headings under "SEQUENCE CHARACTERISTICS")
(ix) SEQUENCE DESCRIPTION: SEQ ID NO:X:
This sequence is intentionally skipped.

Please also adjust the (ai) NUMBER OF SEQUENCES: response to include the skipped sequence(s).
- 9 Skipped Sequences (NEW RULES) Sequence(s) missing. If intentional, please use the following format for each skipped sequence.
<10> sequence id number
<400> sequence id number
000
- 10 Use of n's or Xaa's (NEW RULES) Use of n's and/or Xaa's have been detected in the Sequence Listing. Use of <220> to <223> is MANDATORY if n's or Xaa's are present. In <220> to <223> section, please explain location of n or Xaa, and which residue n or Xaa represents.
- 11 Use of <213> Organism (NEW RULES) Sequence(s) are missing this mandatory field or its response.
- 12 Use of <220> Feature (NEW RULES) Sequence(s) are missing the <220> Feature and associated headings. Use of <220> to <223> is MANDATORY if <213> ORGANISM is "Artificial" or "Unknown". Please explain source of genetic material in <220> to <223> section.
(See "Federal Register," 5/01/98, Vol. 63, No. 104, pp. 29631-32) (Sec. 1.823 of new Rules)
- 13 PatentIn ver. 2.0 "bug" Please do not use "Copy to Disk" function of PatentIn version 2.0. This causes a corrupted file, resulting in missing mandatory numeric identifiers and responses (as indicated on raw sequence listing). Instead, please use "File Manager" or any other means to copy file to floppy disk.

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H. HOLLER

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8 ALH
9/27/01

1642

RAW SEQUENCE LISTING
PATENT APPLICATION: US/09/251,133DATE: 09/20/2000
TIME: 16:21:27Input Set : A:\Jumeg15
Output Set: H:\CRF3\09202000\I251133.FAQDoes Not Comply
Corrected Diskette Needed

3 <110> APPLICANT: SHAR, Garish V.
5 <120> TITLE OF INVENTION: NEUROENDOCRINE MARKER OF PROSTATE CANCER AND METHOD FOR
6 PRODUCING SAME
8 <130> FILE REFERENCE: 70009590-015
10 <140> CURRENT APPLICATION NUMBER: 09/251,133
11 <141> CURRENT FILING DATE: 1999-02-16
13 <150> PRIOR APPLICATION NUMBER: US 60/074,809
14 <151> PRIOR FILING DATE: 1998-02-17
16 <160> NUMBER OF SEQ ID NOS: 12
18 <170> SOFTWARE: PatentIn Ver. 2.0

ERRORD SEQUENCES

97 <210> SEQ ID NO: 3
98 <211> LENGTH: (433) 432
99 <212> TYPE: DNA
100 <213> ORGANISM: Homo sapien
102 <400> SEQUENCE: 3
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104 gggctcctta gacctgttct acctcacaaca tctgcaagaa atccctctac gttctaggca 120
105 agtagacctga atctctctct tctctctctt tctctctctt tctctctctt tctctctctt 180
106 ggggacacgaa cctcagagcct tgcgttctgt aggcacagcgc tctacacactg agctcactcg 240
E--> 107 caaacacagac tgcacatgtt tctgtctctt gctaacctctt ggtctgctct atctctctct 300
E--> 108 tctctctctt tctctctctt tctctctctt tctctctctt tctctctctt tctctctctt 360
E--> 109 gaggcaggag gctccagagt tcaagtcagg atggcacaca tgagacatta gctcaaaaaa 420
E--> 110 aaaaaaaaaa aaaa
129 <210> SEQ ID NO: 5
130 <211> LENGTH: (435) 434
131 <212> TYPE: DNA
132 <213> ORGANISM: Homo sapien
134 <400> SEQUENCE: 5
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136 ctgggggtccc ctatgtctgt ttccttcaaa catatgcaag acattcctca agcttatagc 120
137 caagtacact gactcctctt tctctctctt tctctctctt tctctctctt tctctctctt 180
138 ctggggacagg aacctcaggac ctctggctct ctgggcaagc gctctacac tgagctaaat 240
139 tcccaaccccc gactgcacat tctctgttct ctatgtaaat tccggtctgc tctattctgt 300
E--> 140 gctccctctt gctcaaaaaga aactgtctggg ggggtatgat atctctctaa tccctgcaat 360
E--> 141 tgggagggcag gaggatcaga agttcaggac ggcattggac acatgagacb ctgctcctaa 420
E--> 142 aaaaaaaaaa aaaa
183 <210> SEQ ID NO: 9
184 <211> LENGTH: 103
185 <212> TYPE: PRT
186 <213> ORGANISM: Homo sapien
188 <400> SEQUENCE: 9
189 Arg Thr Cys Val Leu Gly Tyr Leu His Ile Val Pro Glu Phe Ile Glu
190 1 5 10 15

invalid base (nuclei)
designator and
nos. off, as a result
of above error

359
numbering off

see next page

RAW SEQUENCE LISTING

PATENT APPLICATION: US/09/251,133

DATE: 09/20/2000

TIME: 16:21:27

Input Set : A:\Xmed15

Output Set: H:\CRF3\09202000\I251133.raw

```

182 Ser Gln Leu Leu Gly Leu Leu Ser Pro Val Ser Phe Asn His Met Gln
193      20      25      30
195 Asp Ile Pro Gln Arg Tyr Arg Gln Val Asp Cys Ile Phe Phe Phe Leu
196      35      40      45
198 Phe Phe Ser Phe Ser Phe Phe Phe Phe Ser Glu Leu Gly Thr Glu Pro
E--> 199      50      55      60
201 Arg Thr Leu Arg Leu Leu Gly Lys Arg Ser Thr Thr Glu Leu Asn Pro
E--> 202 665      60      65      70      75      80      85
204 Gln Pro Arg Leu His Arg Phe Trp Phe Leu Val Lys Phe Arg Phe Ala
E--> 205      85      90      95
207 Leu Phe Arg Val Pro Phe Val
E--> 208

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misaligned
amino acid nos.

(see item 4
on Ena Summary
sheet)

PT

Please Note:

Use of n and/or Xaa have been detected in the Sequence Listing. Please review the Sequence Listing to ensure that a corresponding explanation is presented in the <220> to <223> fields of each sequence which presents at least one n or Xaa.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/201-138	02/16/94	SHAH	70009590-001

DAVID G ROSENBAUM
SONNENSCHNEIN MATH & ROSENTHAL
3000 PEARLS TOWER
500 SOUTH WACKER DRIVE
CHICAGO IL 60606-6404

HM22/1094

EXAMINER

POLLERAN, A

ART UNIT

PAPER NUMBER

1642

9

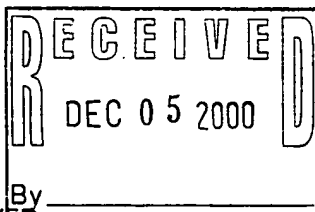
DATE MAILED:

10/04/00



Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



RECEIVED _____ DOCKET
DOCKETED Response
DIARIED 11-4-00
BY [Signature]



PATENT

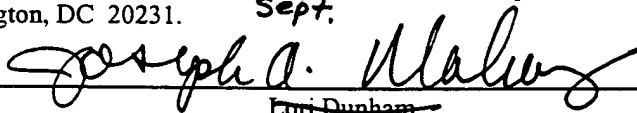
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Girish V. Shah
SERIAL NO.: 09/251,133 EXAMINER: A. Holleran
FILING DATE: 17 February 1999 AU: 1642
TITLE: NEUROENDOCRINE MARKER OF PROSTATE
CANCER AND METHOD FOR PRODUCING SAME

Assist. Commissioner for Patents
Washington, D.C. 20231

CERTIFICATE OF MAILING

I hereby certify that this document (along with any being referred to attached and/or enclosed) are being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" Mailing Label No. EM 143 604 465 US on this 1 day of ~~July~~ ^{Sept.}, 2000 in an envelope addressed to the Assist. Commissioner for Patents, Washington, DC 20231.


~~Eori Dunham~~

NOTICE OF CHANGE OF ADDRESS OF
ATTORNEY OF RECORD

Dear Sir:

Please correct your records to reflect a new attorney of record as follows:

Joseph A. Mahoney, Reg. No. 38, 956
SONNENSCHN NATH & ROSENTHAL
8000 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6404
(312) 876-3119



PATENT

Client Name: No. Ku Medical Center Research, Inc. 70009590-0015
Title: Anticancer Marker of Prostate Cancer and Method
Applicant: Girish V. Shah
Ser.# / Pat.# 09/251,133 Filing Date: 2/16/99

Please acknowledge receipt of:

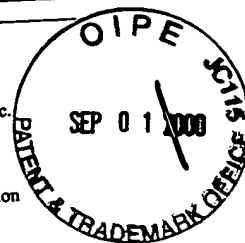
- ☐ Specification and claims, and sheets of drawings, FIG(S).
- ☐ Declaration / Oath
- ☐ Power of Attorney
- ☐ Small Entity Statement
- ☐ Check # _____
- ☐ Patent Assignment Cover Sheet
- ☐ Assignment
- ☐ Check # _____
- ☒ Letter - *notice of change of attorney + address*
- ☐ Information Disclosure Statement
- ☐ Form PTO-1449 & Refer.
- ☐ Certification
- ☐ Petition
- ☐ Check # _____

Mailed 9/1/00

- ☐ Preliminary Amendment
- ☐ Request for Priority and Pri. Doc.
- ☒ Reply to Office Action
- ☒ Request for Ext. of Time
- ☐ Check # _____
- ☐ Amendment After Final Rejection
- ☐ Request for Ext. of Time
- ☐ Check # _____
- ☐ Corrected Drawings
- ☐ Issue Fee Transmittal
- ☐ Check # _____
- ☐ Other *paper copy - see letter and comp. readiness form - div 1*

Maintenance Fee Transmittal Form

- ☐ Check # _____
- ☒ Cert. of Mailing
- Express Mail No. EM143604465
- By Barbara Balsamo



EM143604465US